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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,873	03/06/2002	Daniel R. Potter	005127.59792	9984
22909	7590	07/28/2004	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,873

Applicant(s)

POTTER ET AL.

Examiner

Art Unit

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 18-25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 18-25 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 05/12/04 6) ☒ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant has requested clarification of the Final made on the restriction. Claims 9-17 and 26-28 were determined to not read on the elected species and were therefore withdrawn from consideration. Although applicant stated that claims 9-17 and 26-28 read on the elected species, the examiner read through all the claims which applicant stated “read on” the elected species and determined that claims 9-17 and 26-28 did not read on the elected species as they contained limitations that were not present in the elected species. Thereby, claims 9-17 and 26-28 are withdrawn from consideration and the **Final** made in the previous Office action stands.

Information Disclosure Statement

2. The information disclosure statement filed May 12, 2004 have been considered and entered into the application.

Specification

3. The attempt to incorporate subject matter into this application by reference to the prior patents is improper because most of the prior patents incorporated by reference other references themselves. It is improper to incorporate by reference another reference, which in itself incorporated by reference a previous reference. It appears that the essential subject matter of the references attempted to be incorporated by reference is along the lines of the material of the bladder and how the air diffuses through the material. Applicant asks for the examiner to provide “a reference to a legal source that supports this assertion”. Included as an attachment to

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this Office action is a copy of MPEP § 608.01 (p), Section I, part A, paragraph 2 where it clearly states that “In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to ... (3) a U.S. patent or application which itself incorporates “essential material” by reference, ...”. Since the U.S. patents attempted to be incorporated by reference by the applicant itself incorporates by reference another U.S. patent, applicant cannot incorporate by reference those U.S. patents according to this section of the MPEP. As a courtesy to the applicant, a copy of the section of the MPEP that teaches how the improper incorporated by reference material can be corrected in the specification.

4. The disclosure is objected to because of the following informalities: Reference number 14 is referred to as a “chamber” throughout the written disclosure. This language used to describe part 14 is confusing, as it appears that reference 14 is actually an insert that contains chambers 13 and not a chamber in and of itself. To clarify the description, it appears that reference number 14 should be referred to as an “insert” throughout the written disclosure. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Town 2,762,134. Town ‘134 discloses all the limitations of the claims including the following: a

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bladder (Figure 1) for footwear comprising a sealed first chamber (formed by 101 and 11) being formed of a barrier material and containing fluid at a first pressure (ambient air); a sealed second chamber (formed by 14 and 15) formed of a second barrier material and containing fluid at a second fluid pressure greater than the first fluid pressure (second chamber sealed and pressurized); the second chamber being operatively coupled to the first chamber (located within the first chamber) such that inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber to increase the fluid pressure and the amount of fluid within the first chamber (air leaves first chamber must travel into second chamber); the fluid contained in the first chamber includes a gas (air); the first chamber surrounds at least a portion of the second chamber (see Figures 2 and 3); the inflation fluid includes an inflation gas (air); the second chamber is formed of barrier material that is different from the barrier material of the first chamber (second chamber material must be as impervious as possible to the passage of air whereas this is not required of first chamber material); the barrier material of the second chamber is constructed so that inflation gas diffuses out of the second chamber and into the first over a predetermined period of time (known failure time of material of second chamber); the second chamber releases gas to the first chamber by fatigue failure of the second chamber barrier material (second chamber breaks, fluid from second chamber enters first chamber); the second chamber material is structured to experience fatigue failure following a predetermined number of cycles of compression or flex (the material used for the second chamber would fail after a predetermined number of flexions because that predetermined number would be the amount taken to break the material).

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7. Claims 1-6, 18-23, 29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by McLaughlin 5,979,078. McLaughlin '078 discloses all the limitations of the claims including the following: an upper for covering at least a portion of a foot of a wearer (see Figure 1, reference 75); a bladder 10 for footwear comprising a sealed first chamber (that formed by 50 and 55) being formed of a barrier material and containing fluid at a first pressure (see col. 4, lines 42-55); a sealed second chamber 15 formed of a second barrier material (see col. 3, lines 40-60) and containing fluid at a second fluid pressure greater than the first fluid pressure (see col. 4, lines 18-36); the second chamber being operatively coupled to the first chamber (located within the first chamber) such that inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber to increase the fluid pressure and the amount of fluid within the first chamber; the fluid contained in the first chamber includes a gas (enclosed atmospheric air); the first chamber surrounds at least a portion of the second chamber (see Figures); the inflation fluid includes an inflation gas (see col. 4, lines 18-36); the second chamber is formed of barrier material that is different from the barrier material of the first chamber (see col. 3, lines 40-60 and col. 4, lines 42-55); the barrier material of the second chamber is constructed so that inflation gas diffuses out of the second chamber and into the first over a predetermined period of time (known diffusion property of material used for bladder 15); the second chamber releases gas to the first chamber by fatigue failure of the second chamber barrier material (second chamber breaks, first chamber receives gases from second chamber); the second chamber material is structured to experience fatigue failure following a predetermined number of cycles of compression or flex (the material used for the second chamber would fail after a predetermined number of flexions because that predetermined number would be the amount taken to break the material) ; the

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second chamber barrier material is more brittle than the first chamber material (see above noted type of material for use of bladder); the second chamber releases gas to the first chamber by diffusion of the gas through the second chamber material over time (any gas that normally diffuses through material of bladder 15 will be caught by outer envelope).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18-22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Town 2,762,134 as applied above in view of Rees 2,677,906. Town '134 as applied above discloses all the limitations of the claims except for the article of footwear having an upper for covering at least a portion of the foot of the wearer. Although insole bladder is of the type disclosed in Town '134 are typically used in athletic shoes that have uppers attaching the shoe to the user's foot, Reed '906 teaches that a shoe with an upper can contain a cushioning bladder located within it. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the bladder of Town '134 into an athletic shoe with an upper, as taught by Reed '906, to aid in cushioning the user's foot during impact of the shoe with the ground.

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10. Claims 7-8, 24-25, 30-31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin 5,979,078 as applied to claims 3, 5, 19, 20, 29 and 32 above in view of Huang 5,902,660. McLaughlin '078 as applied above discloses all the limitations of the claims except for the second chamber having a preformed weakness and the second chamber releasing the inflation fluid to the first chamber by manual actuation of the chamber. Huang '660 teaches (Figure 11) that a bladder with an internal chamber and an external chamber can have a weakness (the edge of the internal bladder) in the internal bladder that allows for the fluid of the internal bladder to exit the internal bladder and enter the external bladder, thereby inflating the external bladder. This allows for different inflation pressures to be placed within the inner and outer air cushions. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the internal bladder with an opening that was later closed to allow for the pressurization of the different air cushions by manual compression.

Response to Arguments

11. Applicant's arguments filed May 12, 2004 have been fully considered but they are not persuasive. Applicant argues that there is no disclosure in town that one cushion is pressurized higher than the other. This argument is not clearly understood. Town teaches that when the pressure in one chamber gets too high, the air transfers to the other chamber. If the pressures in the two chambers were the same pressure, transfer of air would not occur because the air only transfers from an area of high pressure to an area of lower pressure. Applicant further argues that McLaughlin doesn't teach the flow of fluid from one chamber to another. This argument is also not clear since if the interior chamber were to break, the fluid will flow into the outer

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chamber. Applicant further argues that McLaughlin does not teach the movement of the fluid from the first chamber to the second. This argument is again not clear, as the fluid from the first chamber, located within the second chamber, would increase the pressure in the second chamber when the first chamber leaks, since the first chamber is located within the second chamber. Applicant continues to argue that none of the references teach the second chamber failing after “a predetermined number of flexes”. As all material fails after a “predetermined number of flexes”, known by the testing of the material at a certain wall thickness, the prior art meets this limitation in the claim as a specific predetermined number of flexes is not claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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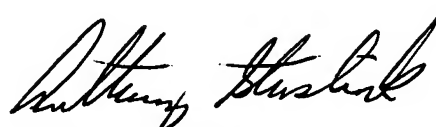
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (703) 308-3876.

The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ADS



ANTHONY D. STASHICK
PRIMARY EXAMINER

I. INCORPORATION BY REFERENCE

The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Commissioner has elected to exercise that discretion. Section A provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section B provides guidance for incorporation by reference in benefit applications; i.e., those domestic (35 U.S.C. 120) or foreign (35 U.S.C. 119(a)) applications relied on to establish an earlier effective filing date.

A. Review of Applications Which Are To Issue as Patents.

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below.

"Essential material" is defined as that which is necessary to (1) describe the claimed

invention; (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application.

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications however, hyperlinks and/or other forms of browser executable code cannot be incorporated by reference. See MPEP § 608.01. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Application No. _____ left blank in the application as filed can be found in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103).

2. Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the reference. In such a case, the applicant will be required to amend the specification to include the material incorporated by reference. The following form paragraphs may be used.

¶ 6.19 *Incorporation by Reference, Foreign Patent or Application*

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

¶ 6.19.01 *Improper Incorporation by Reference, General*

The attempt to incorporate subject matter into this application by reference to [1] is improper because [2].

Examiner Note

1.

In bracket 1, identify the document such as an application or patent number or other identification.

2.

In bracket 2, give reason why it is improper.

The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Reliance on a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See *In re Fried*, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date. *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).